

Appln No. 10/820,480
Amdt date February 23, 2009
Reply to Office action of August 22, 2008

Amendments to the Drawings:

The attached sheets of drawings include changes to Figures 1, 2, 3A, 3B and 4-10. These sheets, which include Figures 1, 2, 3A, 3B and 4-10, replace the original sheets including Figures 1, 2, 3A, 3B and 4-10.

Attachment: Replacement Sheets

REMARKS/ARGUMENTS

In the Final rejection dated August 22, 2008, the Examiner required corrected drawings. In response, applicant submits amended Figures 1, 2, 3A, 3B and 4-10. As the amended drawings do not include hand-drawn figures, applicant submits that they are acceptable formal drawings.

The Examiner also maintained the rejection of claims 1-30 under 35 U.S.C. §103(a) as allegedly obvious over Moaddeb, et al. (U.S. Patent No. 6,405,078) in view of Skalsky, et al. (U.S. Patent No. 4,844,099). In maintaining this rejection, the Examiner asserts that "[i]t is improper for applicant to assume that the Skalsky et al electrode must be used in the same manner (i.e. to attach to tissue) when combined with the Moaddeb et al reference" and that "[t]he skilled artisan would not be required to use such a construction in the exact same manner and would realize that any porous electrode may be fabricated in such a manner and continue to be used for its intended purpose." Office action, page 4. Applicant respectfully traverses these arguments.

Skalsky fails to teach or suggest that the non-conductive porous material is configured to avoid substantial contact with the tissue. Absent such a teaching or suggestion, the skilled artisan lacks any motivation to use such an electrode. While the Examiner states that the skilled artisan "would not be required to use such a construction," the Examiner fails to point to any suggestion or motivation in either Skalsky or Moaddeb to use the recited construction. Such a conclusory statement without explanation is insufficient to support the obviousness rejection. *See KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)("KSR") (stating "[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")(citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). As the Examiner fails to point to any teaching or suggestion in either Skalsky or Moaddeb that the non-conductive porous material is configured to avoid substantial contact with

tissue, the Examiner's continued rejection of the claims based on these references appears to rely on improper hindsight.

In particular, Applicant has demonstrated in the responses filed on August 6, 2007, October 31, 2007 and May 28, 2008 that Skalsky fails to teach or suggest that the non-conductive porous material is configured to *avoid* substantial contact with the tissue, as claimed. Quite to the contrary, Skalsky highlights the need to *maintain* substantial contact of the porous material with the tissue, effectively teaching away from the recited configuration.

Skalsky emphasizes the need for secure and reliable attachment of the electrode to the heart wall. See, e.g., column 2, lines 5-33. To accomplish this, the porous characteristics of the Skalsky implant are used to facilitate attachment to the cardiac tissue by promoting tissue ingrowth. Column 2, line 54 to column 3, line 8. Since the porous substrate disclosed in Skalsky is used to promote tissue ingrowth and ensure secure and reliable attachment of tissue to the device, it *cannot* be "fairly asserted" that the porous substrate is configured to avoid substantial contact with the tissue. Rather, it can only be "fairly asserted" that the porous substrate in Skalsky is adapted to *maximize* contact with tissue in order to effectively promote tissue ingrowth and secure, reliable attachment of the device to the tissue. If the porous substrate in Skalsky were configured to *avoid* substantial contact with the tissue, tissue ingrowth could not occur, and the device could not be attached to the tissue, as required by Skalsky. As Applicant has shown that Skalsky fails to teach or suggest that the porous material is configured to avoid substantial contact with tissue, Applicant submits that the continued obviousness rejection is improper.

The Examiner also appears to argue that combining the porous electrode of Skalsky with the device of Moaddeb would be "an intuitive and obvious design consideration since Moaddeb et al does not require the electrode to be attached to tissue." Office action, page 4. However, the combination of Skalsky and Moaddeb would result in a porous electrode arrangement that *maximizes* contact with tissue to promote tissue ingrowth. As such, the combination of Moaddeb and Skalsky does not teach or suggest that the non-conductive porous material is configured to

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avoid substantial contact with tissue. Accordingly, Applicant submits that claims 1-30 are allowable over Moaddeb and Skalsky.

Claims 1-30 remain pending in this application. In view of the above remarks, Applicant submits that all of pending claims 1-30 are in condition for allowance. Applicant therefore respectfully requests reconsideration and a timely indication of allowance. However, if there are any remaining issues that can be addressed by telephone, Applicant invites the Examiner to contact Applicant's counsel at the number indicated below.

Respectfully submitted,
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